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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,671	03/11/2005	Tetsuo Nakanishi	TAKIT-196	5243

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Arlington Courthouse Plaza I
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EXAMINER

KASSA, TIGABU

ART UNIT	PAPER NUMBER
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1619

MAIL DATE	DELIVERY MODE
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09/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/527,671</p>	<p>Applicant(s) NAKANISHI ET AL.</p>	
	<p>Examiner TIGABU KASSA</p>	<p>Art Unit 1619</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

TK

/Cherie M. Woodward/
Primary Examiner, Art Unit 1647

Continuation of 11. No claim amendments were made.

Claims 2 and 37-38 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Shioya et al. (US Patent No 5,144,054) in view of Sakuta (WO01/92375) using the equivalent US Patent No. 6747115 for translation and Harai et al. (European Patent Specification 0350951, IDS reference), for the reasons of record and the reasons set forth herein.

Response to arguments

Applicant's arguments filed on 08/05/2010 have been fully considered but they are not persuasive.

Applicant argues that in Sakuta (US 6,747, t 15), a polyoxyalkylene-modified cross-linked silicone polymer, a pasty composition containing the said polymer and a cosmetic material are described and it is described that fluoroalkyl group-containing polyether-modified silicone can be used as a non-ionic surfactant ... (Lines 16-19, Lines 54-57, Column 12) and, regarding the said fluoroalkyl group-containing polyether-modified silicone, "if p exceeds 2.0, ..., so sufficient emulsification is no longer obtained" is described (Lines 2-5, Column 13). Considering the above aspects, one of ordinary skill in the art could predict easily that, in Sakuta's invention, an emulsion material excellent in emulsion stability can be obtained by using the glycerol-modified silicone of Shioya instead of the fluoroalkyl group-containing polyether-modified silicone, that is, by mixing the glycerol-modified silicone of Shioya with the cross-linked organopolysiloxane polymer of Sakuta. However, one of ordinary skill in the art would not find a reason to introduce a glycerol group instead of a polyoxyalkylene group into the cross-linked silicone in Sakuta.

This is not found persuasive because applicant's are attacking the references individually while the rejection is based on the combined teachings of the prior art references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's assertion is completely unsubstantiated by the evidence. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. One of ordinary skill in the art would not have any reason to put a glycerol group in Sakuta's composition one of ordinary skill in the art already has a great understanding of from the teachings of Shioya et al., that organopolysiloxane polymer having a glycerol derivative (column 23, example 10, lines 50-53) can be incorporated in such a composition. Shioya et al., teach novel siloxane derivatives having surface active action useful as an emulsifier capable of excellent emulsification stability and having good fitness, good slip, good cosmetic adhesiveness, and good usage feeling (column 2, lines 6-12). Shioya et al. teach an organopolysiloxane polymer having a glycerol derivative (column 23, example 10, lines 50-53), which addresses the limitations of the elected species combination, specifically the variables recited in instant claim 2, for (a2) where $1.0 \leq d \leq 2.3$, $0.001 \leq e \leq 1.0$ and R1 is a substituted or unsubstituted monovalent hydrocarbon group having 1-30 carbon atoms, furthermore, for (b1) where f is an integer from 2-10 and R3 is an alkenyl group having 2-20 carbon atoms have been addressed by the teachings of Shioya et al. Sakuta is merely incorporated in the rejection not for the reasons of an organopolysiloxane polymer having a glycerol derivative rather for teaching a three dimensional cross-linked structure and the types of liquid oils that are not taught by Shioya et al., It would have been prima facie obvious to the ordinarily skilled artisan to crosslink the organopolysiloxane of Shioya et al. because Sakuta teaches the cross-linking of silicone polymers (abstract). The skilled artisan would have been motivated to crosslink the polymer so as to achieve excellent water and oil repellence wherein the polymer swells relative to the oils (Sakuta, column 2, lines 10-14 and lines 5-7) and thereby achieve a more stable, functional cosmetic composition. The skilled artisan would have a reasonable expectation of success because cross-linking polymers, including polyorganosiloxanes, are well known in the art as evidenced by Sakuta. Moreover, the polymers taught by Sakuta and Shioya et al. are similar polymers which both contain the instantly selected species a2. The incorporation of the glycerol moiety is clearly taught by the primary reference Shioya et al. On the other hand, Sakuta is incorporated in the reference to clearly show that cross-linking organopolysiloxanes is a commonly known procedure conventionally performed by one of ordinary skill in the art and it has advantages such as excellent water and oil repellence wherein the polymer swells relative to the oils and thereby achieve a more stable, functional cosmetic composition. Sakuta does not have to teach the incorporation of the glycerol moiety because that limitation is clearly taught by Shioya et al. Furthermore, the polymer structure taught by Shioya et al. reveals that the free hydroxyl groups available on the glycerol moiety can undergo further cross-linking reactions.

Applicant also asserts that, as is clear from the comparison between Examples 11-12 and Comparative Examples 1-2 in the present specification, it is demonstrated that the cosmetic material using the glycerol-modified cross-linked organopolysiloxane in the present application is significantly much more excellent than the one using polyoxyalkylene-modified cross-linked organopolysiloxane (Page 49, English Specification). However, regarding Examples 11-12 in the present application, Examiner mentioned that "Although ... assertion..." (Lines 3-6, Page t 0, OA) and "applicant really also..., it does not state cross-linked polyglycerol modified silicone" (Lines 5-1 5, Page t 0, OA), which are only about Example 12, but not about Example 11.

In Example 11, not uncross-linked polyglycerol-modified silicon, but cross-linked polyalcohol-modified silicone only is used as a polyglycerol-modified silicone, which exhibits very good moistness after use and long term moistness (Page 49, English Specification). However, the Office Action concluded that "the result provided in ... Examples 11-12 and ..." (Lines 15-20, Page 10) by ignoring the effect of Example 11 of the present application wherein uncross-linked polyglycerol-modified silicone is not used, which is unreasonable. Furthermore, the Office Action alleges that "The assessment is ...objectively." However, the evaluation was carried out by 50 panels. Since it shows sufficient objectivity obtained from 50 panels, the Office Action's allegation is improper.

This is not found persuasive because of exactly the same reasons set forth in the previous office action which is also delineated below. With regard to the unexpected results applicants allege, applicants' assertions hinge on the arguments filed on 08/14/09 that compositions in examples 11 and 12 which contain polyglycerol-modified silicone have shown very good moistness after use and long term moistness than cross-linked polyether-modified silicone containing composition. The examiner also brings to applicant's attention that example 11 which applicant's allege also demonstrated the unexpected result does not actually incorporate the crosslinked polyglycerol-modified silicone as they allege but it contains neither crosslinked polyglycerol-modified silicone and crosslinked polyether-modified silicone nor uncrosslinked polyglycerol-modified silicone and uncrosslinked polyether-modified silicone. On the contrary example 11 is an example wherein very good moistness after use and long term moistness are achieved without the incorporation of the crosslinked polyglycerol-

modified silicone which applicant's allege is the main reason for the unexpected property. Therefore, the examiner maintains his rebuttal arguments set forth in the previous office action mailed on 09/23/09 and incorporates them in the instant office action as set forth below. Although the examiner acknowledges that applicant's qualitative data indicates that the composition of examples 11-12 were relatively having very good moistness after use and long term moistness in general, the examiner respectfully disagrees with applicant's assertion that this is due to the incorporation of cross-linked polyglycerol derivative. On the contrary applicant really also proved that a composition containing polyglycerol-modified silicone just exactly the same as Shioya et al. also exhibited very good moistness after use and long term moistness in general (example 12). Example 12 shows the incorporation of uncross-linked polyglycerol-modified silicone which is exactly the same as the polymer taught by Shioya et al., which is a species of polyglycerol-modified silicone. Applicants as distinctly differentiate between cross-linked polyether-modified silicone and polyether-modified silicone, applicant clearly states that in example 12 the polymer is polyglycerol-modified silicone it does not state cross-linked polyglycerol-modified silicone. Furthermore, the results provided in the specification have been reviewed and are not considered to be unexpected results because the data submitted comparing the assessment of Examples 11-12 and comparative examples 1-2 contains a comparison of the moistness and long-term moistness. Simply stating that Examples 11-12 result in a very good moistness and long-term-moistness does not provide sufficient weight to overcome the instant rejection. The assessment is subjective and lacks a reasonable level of scientific objectivity. Applicant did not address the examiner's assertions set forth above in order to demonstrate the unexpectedness of the results.

Applicant also argues that the Office Action also alleges that "Harai et aladhesiveness" concerning Harai. However, Harai mentions adhesive agent and, therefore, it is completely different from the organopolysiloxane polymer of the present application used for cosmetic material in the way of using, and it is impossible to consider "tack" (adhesiveness) required in cosmetic material which is applied on the human face and "tack" (adhesiveness) required in adhesive agent which bonds physical matters to each other as the same quality. Therefore, the Office Action's allegation described above is not correct. The adhesive composition of Harai comprises (A) alkenyl group-containing organopolysiloxane, (B) organohydrogenpolysiloxane, (C) wet-method hydrophobized reinforcing silica, (D) acryl-functional silane coupling agent or methacryl-functional silane coupling agent, (E) epoxy-functional silane coupling agent and (F) partial allyl ether of multivalent alcohol as an essential component. In the present claims, none of the above components (A), (C), (D) and (E) are used for synthesizing the orgmopolysiloxane polymer. In Harai's invention, even though diglycerol diallyl ether is used as the component (F), the reaction product of these componems is a structurally complicated cross-linked type compound, which shows clearly that Harai never suggests the organopolysiloxane polymer of the present claims.

This is not found persuasive because the motivation to combine the references does not necessarily have to match with what applicants want to accomplish. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

Applicant also argues that the Office Action further alleges that "applicant's claim ... or method steps" (Lines 10-14, Page 11, OA). However, "An organopolysiloxane polymer ...of a liquid oil ..." is described in present Claim 2. In the present Claim 2, "containing..." mentions only properties of organopolysiloxane polymer after "which can swell" and, in fact, the organopolysiloxane polymer of the present Claim 2 does not contain an oil. Therefore, "containing" in the present Claim 2 is not used as "transitional term."

The examiner acknowledges that applicant's way of interpretation may be correct however still applicant's claim language uses the transitional phrase "having". Transitional phrases such as "having" must be interpreted in light of the specification to determine whether open or closed claim language is intended. See, e.g., *Lampi Corp. v. American Power Products Inc.*, 228 F.3d 1365, 1376, 56 USPQ2d 1445, 1453 (Fed. Cir. 2000) (The term "having" was interpreted as open terminology, allowing the inclusion of other components in addition to those recited); *Crystal Semiconductor Corp. v. TriTech Microelectronics Int'l Inc.*, 246 F.3d 1336, 1348, 57 USPQ2d 1953, 1959 (Fed. Cir. 2001).

Applicant has not demonstrated how the instantly claimed product is patentably distinct from the cited prior art nor do the claims as currently written distinguish the instant invention over the prior art. In light of the forgoing discussion, one of ordinary skill in the art would have concluded that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.